

**Amendments to the Drawings:**

Replacement sheets representing formal drawings of Figures 1-9 are being submitted herewith. No amendments to the drawings have been made by way of this paper. The replacement sheets of formal drawings include the amendments to Figures 2, 4 and 5 filed April 25, 2005, and accepted by the Examiner. Applicants request consideration and approval of the formal drawings by the Examiner.

Enclosures: Replacement Figures 1-9

## REMARKS

Claims 1, 3, 5-17, and 20-32 are pending in the application.

In the non-final second Office Action mailed on July 21, 2005, the Examiner rejected claims 1, 3, 5-13, 20-24, 31, and 31, and allowed claims 14-17 and 26-30.

The drawings filed on December 9, 2003 and April 25, 2005 are accepted.

### **Claim Rejections – 35 U.S.C. § 112**

Claims 1, 3, 5-9, and 20-23 are rejected under 35 U.S.C. §112, first paragraph, in that the claims recite that the recording element has an "inherent durability characteristic". The Examiner states no support for this language could be found in the specification.

The Examiner appears to be of the opinion that there is no support in the specification for the word "inherent" in the claims. Such support was indicated in the Amendment filed 4/25/2005. However, the Examiner has failed to address this indication of support.

In any event, support for the word "inherent" can be found in the specification, for example, at 11:17-22, 27-29 and 12:18-20 which states that at least the uppermost layer of the recording element 38 is of the type that a durability characteristic of the recording element is capable of being increased. Also, see 28:8-29:6 in the specification which describes the use of a polymer in the recording element. Polymers are well known to have an inherent or intrinsic durability characteristic. Thus, these portions of the specification indicate that the durability characteristic is inherent or intrinsic in the recording element, rather than one that is added after preparation of the recording element.

Moreover, a new paragraph consistent with the support in the specification for the word "inherent" has been added to the specification as follows:

*--It will be recognized that the durability characteristic of the recording element is inherent, i.e. intrinsic, rather than one that is added after manufacture of the recording element. See the description of the preparation of the recording element which follows under the heading "**Experimental Results**"--*

If the Examiner disagrees with the foregoing, he is requested to explain in particular his reasons why the above-referenced portions of the specification do

not indicate that the durability characteristic of the recording element 38 is inherent or intrinsic, rather than one that is added after manufacture of the recording element.

**Claim Rejections – 35 U.S.C. § 102**

Claims 1, 8, 20 and 22 are rejected under 35 U.S.C. §102(b) as being anticipated by Kaneda et al. (US 6,444,379) – first interpretation.

Claims 1, 9-10 and 24 are rejected under 35 U.S.C. §102(b) as being anticipated by Kaneda et al. (US 6,444,379) – second interpretation.

**Claim 1:**

Claim 1 is amended as follows:

1. *An apparatus for treating a recording element having an inherent durability characteristic that is capable of being increased and including a carrier that can be removed from the recording element, said apparatus comprising:*

*a carrier removal station adapted to remove a predetermined percentage of the carrier from the recording element; and*

*a converting station positioned downstream from the carrier removal station adapted to increase the inherent durability characteristic of the recording element;*

*wherein the predetermined percentage of the carrier that is removed from the recording element by the carrier removal station is ~~based on~~ a minimum amount ~~that needs to be removed~~ necessary to prevent blistering of the recording element at the converting station when the inherent durability characteristic of the recording element is increased at the converting station.*

In Kaneda et al. (FIG. 3), a liquid developer including a toner particle component is added at a toner development portion 15 to a material 1 to be developed. Then, the material 1 is advanced between a pair of liquid squeezing rollers 14 which squeeze excess liquid developer remaining on the material, and from the rollers to a drying portion (not shown) and thence to a thermal fixing portion (not shown). See 19:11-47.

In Kaneda et al., there is no indication that the rollers 14 serve a drying function as the Examiner has concluded, since they simply remove excess

liquid preparatory to the drying operation downstream from the rollers.

Removing excess liquid does not constitute drying.

In Kaneda et al., the toner particles are a polymer material as described at 22:22-40, and after being added to the material 1 might effect a durability characteristic at the drying and thermal fixing portions. In contrast, claim 1 calls for the durability characteristic to be present in the material before the material is at the carrier removal station and the converting station.

In Kaneda et al., the material 1 is not disclosed to have an inherent or intrinsic durability characteristic as in claim 1. Instead, the durability characteristic is added via the toner particles (polymer) after manufacture of the material 1.

In Kaneda et al., there is no disclosure as in claim 1 that *the predetermined percentage of the carrier that is removed from the recording element by the carrier removal station is a minimum amount necessary to prevent blistering of the recording element at the converting station when the inherent durability characteristic of the recording element is increased at the converting station.* (See 22:21-24 in the specification for support of this subparagraph.) This subparagraph must be considered when applying Kaneda et al. to claim 1 since it is a positive recital of structure.

The Examiner states that in Kaneda et al. the converting station or thermal fixing station uses heat to fix the recording element or material 1, and therefore the thermal fixing portion is increasing a durability characteristic "that is already part of (or inherent in)" the material 1. The quoted portion of the statement is believed to be in error since something added to the material 1, i.e. the toner particles, is not inherent or intrinsic to the material.

Accordingly, claim 1 is allowable over Kaneda et al.

Claim 20:

Claim 20 is a method alternative to the apparatus of claim 1, and therefore is allowable over Kaneda et al. for the same reasons that claim 1 is allowable over Kaneda et al.

Claim 10:

Claim 10 is amended as follows:

10. An apparatus for treating a recording element having a durability characteristic, comprising:

*a carrier removal station adapted to remove a predetermined percentage of a carrier present in the recording element;*

*a converting station positioned downstream from the carrier removal station adapted to increase a durability characteristic of the recording element; and*

*a preheating station positioned between the carrier removal station and the converting station.*

*wherein the predetermined percentage of the carrier that is removed from the recording element by the carrier removal station is a minimum amount necessary to prevent blistering of the recording element at the converting station when the inherent durability characteristic of the recording element is increased at the converting station.*

In Kaneda et al., there is no disclosure as in claim 10 that *the predetermined percentage of the carrier that is removed from the recording element by the carrier removal station is a minimum amount necessary to prevent blistering of the recording element at the converting station when the inherent durability characteristic of the recording element is increased at the converting station.* (See 22:21-24 in the specification for support of this subparagraph.) This subparagraph must be considered when applying Kaneda et al. to claim 1 since it is a positive recital of structure.

The Examiner states that in Kaneda et al. the drying portion, not shown, can be viewed as a "preheating" portion between the carrier removal portion 14, i.e. the liquid squeezing rollers, and the thermal fixing portion, not shown. This is believed to be in error. Kaneda et al. does not disclose as in claim 10 *a preheating station positioned between the carrier removal station and the converting station.* The drying portion in Kaneda et al. is not disclosed to be a preheating portion.

Accordingly, claim 1 is allowable over Kaneda et al.

Claim 24:

Claim 24 is a method alternative to the apparatus of claim 10, and therefore is allowable over Kaneda et al. for the same reasons that claim 10 is allowable over Kaneda et al.

Claim 25:

Claim 25, which depends from independent claim 24 and which the Examiner indicated is allowable in substance, is amended to include the subject matter of claim 24.

Accordingly, claim 25 is allowable over Kaneda et al.

Claim 8:

Claim 8 recites that the carrier removal station is adjacent the converting station. In this regard, the Examiner states that the drying and thermal fixing portions, not shown, in Kaneda et al are "adjacent" to one another. There is no such disclosure in Kaneda et al. If the Examiner disagrees, he must indicate where this is disclosed in Kaneda et al.

Accordingly, claim 8 is allowable over Kaneda et al.

Claim 9:

The Examiner states that in Kaneda et al. the drying portion, not shown, can be viewed as a "preheating" portion between the carrier removal portion 14, i.e. the liquid squeezing rollers, and the thermal fixing portion, not shown. This is believed to be in error. Kaneda et al. does not disclose as in claim 9 *a preheating station positioned between the carrier removal station and the converting station*. The drying portion in Kaneda et al. is not disclosed to be a preheating portion.

**Claim Rejections – 35 U.S.C. § 103**

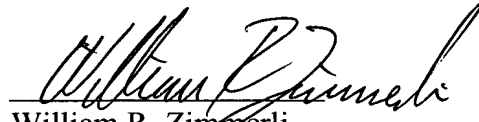
Claims 3, 5-7, 11-13, 21, 23, 31, and 32 depend from independent claims which are indicated above are believed to be allowable over Kaneda et al. Thus, at least for this reason claims 3, 5-7, 11-13, 21, 23, 31, and 32 should be allowed.

**CONCLUSION**

It is respectfully submitted that, in view of the foregoing amendments and remarks, this application is now in condition for allowance.

The Examiner is invited to call the undersigned in the event that a phone interview will expedite prosecution of this application towards allowance.

Respectfully submitted,

  
William R. Zimmerli  
Attorney for Applicant(s)  
Registration No. 45,287

WRZ/ld

Enclosures: Replacement sheets for Figs. 1-9

Rochester, NY 14650

Telephone: (585) 588-2758

Facsimile: (585) 477-4646

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.